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<div>EXAMINER</div> <div>MURDOUGH, JOSHUA A</div>				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/606,507

Applicant(s)

ATHENS ET AL.

Examiner

JOSHUA MURDOUGH

Art Unit

3621

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 January 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 12-15, 18-27, 29-32, 42 and 43 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 12-15, 18-27, 29-32, 42 and 43 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 June 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Acknowledgements

1. In view of the appeal brief filed on January 15, 2008 (First Appeal Brief”), PROSECUTION IS HEREBY REOPENED. A new Office Action is set forth below.
2. To avoid abandonment of the application, appellant must exercise one of the following two options:
 - (1) a reply under 37 C.F.R. §1.111 or,
 - (2) initiate a new appeal by filing a notice of appeal under 37 C.F.R. §41.31 followed by an appeal brief under 37 C.F.R. §41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 C.F.R. §41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.
3. Claims 12-15, 18-27, 29-32, 42, & 43 are currently pending.

Specification

4. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 C.F.R. §1.75(d)(1), and MPEP §608.01(o), and MPEP §2181 IV. and its discussion of 37 C.F.R. §1.75(d). Correction of the following is required:
 - i. The “means for receiving a first audit record, a second audit record, and usage data” as recited in claim 25.
 - ii. The “means for verifying the first and second digital signatures” as recited in claim 25.

- iii. The “means for determining a difference the value of at least one register at the end of the audit period and the start of the audit period” as recited in claim 25.
- iv. The “means for comparing the determined difference with corresponding data provide in the usage data” as recited in claim 25.
- v. The “means for generating a usage report” as recited in claim 25.
- vi. The “means for verifying the time stamp” as recited in claim 26.
- vii. The “means for indicating an error” as recited in claim 27.
- viii. The “means for storing the first audit record” as recited in claim 29.
- ix. The “means for retrieving the stored first audit record” as recited in claim 29.

Appropriate correction is required.

Claim Objections

- 5. Claims 25-27, 29-32, and 43 are objected to because of the following informalities: In claim 25, lines 15-16, the phrase “corresponding data provide in the usage data.” The Examiner believes “provide” should be “provided.” Appropriate correction is required.
- 6. Claims 14 and 27 are objected to under 37 C.F.R. §1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicants are required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

Claim Rejections - 35 USC § 112 1st Paragraph

7. The following is a quotation of the first paragraph of 35 U.S.C. §112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

8. Claims 25-27, 29-32, and 43 are rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement. The claims contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.
9. In claim 25, the "means for generating a usage report" was not shown in the original disclosure.

Claim Rejections - 35 USC § 112 2nd Paragraph

10. The following is a quotation of the second paragraph of 35 U.S.C. §112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

11. Claims 25-27, 29-32, and 43 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
- a. In claim 25, it is unclear whether the Applicants are claiming the subcombination of "a data center" or the combination of "a data center" and "a dispensing device." If Applicants' intend to claim only the subcombination (*i.e.* "a data center"), the body of the

claim(s) must be amended to remove any positive recitation of the combination.

Currently, claim 25 positively recites the dispensing device.

Alternatively, if Applicants intend to claim the combination, the preamble of the claim must be amended to be consistent with the language in the body of the claim. If this latter is desired, the examiner suggests by way of example only that Applicants draw the claim to a system.

b. Claims 25-27, 29-32, and 43 are rejected because the corresponding structure of the means plus function elements can not be determined. "If one employs means plus function language in a claim, one must set forth in the specification an adequate disclosure showing what is meant by that language. If an applicant fails to set forth an adequate disclosure, the applicant has in effect failed to particularly point out and distinctly claim the invention as required by the second paragraph of section 112." See MPEP § 2181 (II). The specification does not clearly link the corresponding structure to:

- i. the "means for receiving a first audit record, a second audit record, and usage data" as recited in claim 25.
- ii. The "means for verifying the first and second digital signatures" as recited in claim 25.
- iii. The "means for determining a difference the value of at least one register at the end of the audit period and the start of the audit period" as recited in claim 25.
- iv. The "means for comparing the determined difference with corresponding data provide in the usage data" as recited in claim 25.

- v. The “means for generating a usage report” as recited in claim 25.
- vi. The “means for verifying the time stamp” as recited in claim 26.
- vii. The “means for indicating an error” as recited in claim 27.
- viii. The “means for storing the first audit record” as recited in claim 29.
- ix. The “means for retrieving the stored first audit record” as recited in claim 29.

12. For each of the 'means plus function' phrases noted above, Applicants are also required to expressly state if the corresponding structure is software only, hardware only, or a combination of hardware and software. Where the corresponding structure includes some software, Applicants are also required to point out the particular algorithm of the software. When the corresponding structure is software, the software transforms a general purpose computer into a specific, programmed computer. Without the specifically disclosing the algorithm, the corresponding structure remains a general purpose computer thereby resulting in purely functional claiming.

13. ALTERNATIVE REJECTION for Claims 25-27, 29-32, and 43: Applicants have expressly stated in their First Appeal Brief (on page 4, 1st paragraph) in the Summary of Claimed Subject Matter section that the various claimed elements are "controller" 44. However, applying this rational results in an alternative rejection, as it is not clear if *a single controller* is performing all of these functions or if there are (3) three separate controllers for each of the means plus functions. If there is but *multiple controllers*, the claim is indefinite because of duplication of parts. See MPEP §2173.05(o). In other words, it is not clear if a single controller or if multiple controllers would be needed for anticipation/infringement. Alternatively, only a

single controller coupled to a single interface means (*e.g.* a network card) would anticipate claim

25. Based upon Applicants arguments, the latter appears to be not what Applicant intended to claim.

Claim Rejections - 35 USC § 102

14. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

15. Claims 12, 18-25, 29-32, 42, & 43 are rejected under 35 U.S.C. 102(e) as being anticipated by Leon (6,424,954).

16. As to claim 12, Leon shows:

receiving a first audit record from the value dispensing device, (signed message,

Figure 5F, 5214)

the first audit record generated by the value dispensing device (“SMD”) at the start of

an audit period, the first audit record including a value of at least one register

maintained by the value dispensing device at a start of the audit period (Figure 5F,

5214) (Column 18, lines 47-56)

and a first digital signature, (Column 18, lines 47-56 & Column 101, lines 18-20)

receiving a second audit record from the value dispensing device ("SMD"), the second audit record generated by the value dispensing device at the end of the audit period, (signed message, Figure 5F, 5214)

the second audit record including a value of at least one register maintained by the value dispensing device at a end of the audit period, (Figure 5F, 5214) (Column 18, lines 47-56)

and a second digital signature; (Column 18, lines 47-56 & Column 101, lines 18-20)

receiving usage data from the value dispensing device for the audit report; (STATUS message, Column 85, lines 1-6 & following table)

verifying the first and second digital signatures; (Figure 5F, 5218) (Column 61, lines 41-50)

if the first and second digital signatures verify, determining the difference between the value of the at least one register at the end of the audit period and the start of the audit period; (Column 9, lines 11-20)

comparing the determined difference with corresponding data provided in the usage data; (Column 46, lines 48-54)

and if the determined difference correlates with the corresponding data provided in the usage data, generating a usage report for the value dispensing system based on the usage data. (Figure 8F, element 890)

5. As interpreted by the examiner, the reports, according to Leon, are sent at the end of one period, are also considered to be sent at the beginning of the subsequent period. The report at the

end of a period must be completed after the period ends so that every transaction from the period is included. Similarly a report at the beginning of a period must be completed before the period begins so that no transactions from the current period are included. Therefore, in reality, the report does not belong to one transaction period, but to its own reporting period occurring between transaction periods, immediately before one transaction period and immediately after the previous one. (Leon, Figures 5f and 5f-2 show the transition from the registered, or transaction, state to the intermediate, or reporting, state in order to process and report the data and the subsequent return to the registered state when the reporting is finished.)

6. As to claim 18, Leon further shows:

the first audit record is received before the end of the audit period.

Again, this is inherent to the periodic auditing process. The first report would have been at the beginning of the audit period as the second report of the previous audit.

7. As to claim 19, the storage and later retrieval of a record previously sent is inherent to a system that compares the record to a later created one.

8. As to claim 20, Leon further shows:

the at least one register value in the first and second audit records includes a plurality of register values. (Column 18, lines 47-56)

9. As to claim 21, Leon further shows:

the at least one register value in the first and second audit records includes an ascending register value. (Column 99, lines 37-41)

10. As to claim 22, Leon further shows:

the at least one register value in the first and second audit records includes a total piece count register value. (Column 100, lines 44-47)

11. As to claim 23, Leon further shows:

the first and second digital signatures are verified utilizing a public key. 536

12. As to claim 24, Leon further shows:

indicating an error in the processing of the usage data. (Figure 6F)

13. As to claim 25, Leon shows:

means for receiving a first audit record, (Figure 5F, 5214)

a second audit record (Figure 5F, 5214)

and usage data from a value dispensing device, (Column 11, lines 59-61)

the first audit record generated by the value dispensing device at a start of an audit period including a value of at least one register maintained by the value dispensing device at the start of the audit period (Figure 5F, 5214) (Column 18, lines 47-56)

and a first digital signature, (Figure 5F, 5214)

the second audit record generated by the value dispensing device at an end of an audit period including a value of at least one register maintained by the value dispensing device at an end of the audit period (Figure 5F, 5214) (Column 18, lines 47-56)

and a second digital signature; (Figure 5F, 5214)

means for verifying the first and second digital signatures; (Figure 5F, 5218)

means for determining the difference between the value of the at least one register at the end of the audit period and the start of the audit period if the first and second digital signatures verify; (Columns 61-62, lines 51-13)

means for generating a usage report for the value dispensing device based on the usage data if the determined difference correlates with the corresponding data provided in the usage data. (Column 62, lines 14-43)

14. As interpreted by the examiner, the reports, according to Leon, are sent at the end of one period, are also considered to be sent at the beginning of the subsequent period. The report at the end of a period must be completed after the period ends so that every transaction from the period is included. Similarly a report at the beginning of a period must be completed before the period begins so that no transactions from the current period are included. Therefore, in reality, the report does not belong to one transaction period, but to its own reporting period occurring between transaction periods, immediately before one transaction period and immediately after the previous one. (Leon, Figures 5f and 5f-2 show the transition from the registered, or

transaction, state to the intermediate, or reporting, state in order to process and report the data and the subsequent return to the registered state when the reporting is finished.)

15. As to claim 29, the storage and later retrieval of a record previously sent is inherent to a system that compares the record to a later created one.

16. As to claim 30, Leon further shows:

the at least one register value in the first and second audit records includes an ascending register value. (Column 99, lines 37-41)

17. As to claim 31, Leon further shows:

the at least one register value in the first and second audit records includes a total piece count register value. (Column 100, lines 44-47)

18. As to claim 32, Leon further shows:

the first and second digital signatures are verified utilizing a public key. (Figure 5B, 536)

19. As to claims 42 and 43, Leon further shows:

The value dispensing device is a postage meter. (Title)

Claim Rejections - 35 USC § 103

20. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

21. Claims 13-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Leon as applied to claim 12 above, and further in view of Mosher (5,799,322).

22. As to claim 13, Leon further shows:

the first and second audit records each include a respective time stamp, (Column 18, lines 47-56)

Leon does not show:

verifying the time stamp in the first audit record corresponds to the start of the audit period;

and verifying the time stamp in the second audit record corresponds to the end of the audit period.

Mosher shows the verification of time stamps prior to accepting audit data (Columns 31-32, lines 66-8). It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the invention of Leon to add time stamp validation, because this would further show that the data was valid for the audit period and not transactions outside of that time, as is done by Mosher (Column 32, 9-59).

23. As to claim 14, Leon further shows:

indicating an error in the processing of the usage data. (Figure 6F)

24. As to claim 15, Leon further shows:

the time stamp includes a date and a time (Column 18, lines 47-56)

25. Claims 26 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Leon as applied to claim 25 above, and further in view of Mosher (5,799,322).

26. As to claim 26, Leon further shows:

the first and second audit records each include a respective time stamp, (Column 18, lines 47-56)

Leon does not show:

means for verifying the time stamp in the first audit record corresponds to the start of the audit period;

and means for verifying the time stamp in the second audit record corresponds to the end of the audit period.

Mosher shows the verification of time stamps prior to accepting audit data (Columns 31-32, lines 66-8). It would have been obvious to one of ordinary skill in the art at the time of the invention to have further modified the invention of Leon to add time stamp validation, because this would further show that the data was valid for the audit period and not transactions outside of that time, as is done by Mosher (Column 32, 9-59).

27. As to claim 27, Leon further shows:

means for indicating an error in the processing of the usage data if one of , the time stamp in the first audit record or the second audit record does not correspond.
(Figure 6F)

Claim Interpretation

28. It is the Examiner's principal position that conditional or optional limitations that may or may not be required, (*e.g.* "if the first and second digital signatures verify, determining the difference between the value of the at least one register at the end of the audit period and the start of the audit period" in claim 12) are alternative limitation and therefore do not need to be shown in the prior art to establish anticipation. See MPEP § 2106. Applicants are advised that making these positive limitations (in place of the conditional limitations) would require the limitation be shown in the prior art. However, for purposes of compact prosecution only, the Examiner has nevertheless shown these limitations in the applied references above.

17. After careful review of the specification and prosecution history, the Examiner is unaware of any desire—either expressly or implicitly—by Applicants to be their own lexicographer and to define a claim term to have a meaning other than its ordinary and accustomed meaning. Therefore, the Examiner starts with the heavy presumption that all claim limitations are given their ordinary and accustomed meaning. See *Bell Atlantic Network Services Inc. v. Covad Communications Group Inc.*, 262 F.3d 1258, 1268, 59 USPQ2d 1865, 1870 (Fed. Cir. 2001)("[T]here is a heavy presumption in favor of the ordinary meaning of claim language

as understood by one of ordinary skill in the art.”); *CCS Fitness Inc. v. Brunswick Corp.*, 288 F.3d 1359,1366, 62 USPQ2d 1658, 1662 (Fed. Cir. 2002) (There is a “heavy presumption that a claim term carries its ordinary and customary meaning.”). See also MPEP §2111.01 and *In re Zletz*, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989).¹

In accordance with the ordinary and accustomed meaning presumption, during examination the claims are interpreted with their “broadest reasonable interpretation . . .” *In re Morris*, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997). See also MPEP §2111.

However, if Applicants disagree with the Examiner and have either (a) already used lexicography or (b) wish to use lexicography and therefore (under either (a) or (b)) desire a claim limitation to have a meaning other than its ordinary and accustomed meaning, the Examiner respectfully requests Applicants in their next response to expressly indicate² the claim limitation at issue and to show where in the specification or prosecution history the limitation is defined. Such definitions must be clearly stated in the specification or file history. *Bell Atlantic*, 262 F.3d at 1268, 59 USPQ2d at 1870, (“[I]n redefining the meaning of particular claim terms away from the ordinary meaning, the intrinsic evidence must ‘clearly set forth’ or ‘clearly redefine’ a claim

¹ It is the Examiner’s position that “plain meaning” and “ordinary and accustomed meaning” are synonymous. See e.g. *Rexnord Corp. v. Laitram Corp.*, 274 F.3d 1336, 1342, 60 USPQ2d 1851, 1854 (Fed. Cir. 2001) (“[A]ll terms in a patent claim are to be given their plain, ordinary and accustomed meaning . . .”).

² “Absent an *express intent* to impart a novel meaning, terms in a claim are to be given their ordinary and accustomed meaning. [Emphasis added.]” *Wenger Manufacturing Inc. v. Coating Mach. Sys., Inc.*, 239 F.3d 1225, 1232, 57 USPQ2d 1679, 1684 (Fed. Cir. 2001) (citations and quotations omitted). “In the absence of an *express intent* to impart a novel meaning to claim terms, an inventor’s claim terms take on their ordinary meaning. We indulge a heavy presumption that a claim term carries its ordinary and customary meaning. [Emphasis added.]” *Teleflex Inc. v. Ficosa North America Corp.*, 299 F.3d 1313, 1325, 63 USPQ2d 1374, 1380 (Fed. Cir. 2002) (citations and quotations omitted).

term so as to put one reasonably skilled in the art on notice that the patentee intended to so redefine the claim term”).³ The Examiner cautions that no new matter is allowed.

Applicants are reminded that failure by Applicants in their next response to properly traverse this issue in accordance with 37 C.F.R. §1.111(b) or to be non-responsive to this issue entirely will be considered a desire by Applicants to forgo lexicography in this application and to continue having the claims interpreted with their broadest reasonable interpretation.⁴ Additionally, it is the Examiner’s position that the above requirements are reasonable.⁵ Unless expressly noted otherwise by the Examiner (and except for the claim phrases that successfully invoke 35 U.S.C. §112 6th paragraph), the preceding discussion on claim interpretation principles applies to all examined claims currently pending.

³ See also *Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1582, 39 USPQ2d 1573, 1576 (Fed. Cir. 1996), (“[A] patentee may choose to be his own lexicographer and use terms in a manner other than their ordinary meaning, *as long as* the special definition of the term is *clearly stated* in the patent specification or file history. [Emphasis added.]”); *Multiform Desiccants Inc. v. Medzam Ltd.*, 133 F.3d 1473, 1477, 45 USPQ2d 1429, 1432 (Fed. Cir. 1998) (“Such special meaning, however, must be sufficiently clear in the specification that any departure from common usage would be so understood by a person of experience in the field of the invention.”). See also MPEP §2111.01, subsection titled “Applicant May Be Own Lexicographer” and MPEP §2173.05(a) titled “New Terminology.”

⁴ See 37 C.F.R. §1.104(c)(3) which states in part: “the examiner may rely upon admissions by applicant . . . as to *any matter* affecting patentability [Emphasis added.]”

⁵ The Examiner’s requirements on this matter are reasonable on at least two separate and independent grounds. First, the Examiner’s requirements are simply an express request for clarification of how Applicants intend their claims to be interpreted so that lexicography (or even an *attempt* at lexicography) by Applicants is not inadvertently overlooked by the Examiner. Second, the requirements are reasonable in view of the USPTO’s goals of compact prosecution, productivity with particular emphasis on reductions in both pendency and cycle time, and other goals as outlined in the USPTO’s The 21st Century Strategic Plan, 2007 available at www.uspto.gov/web/offices/com/strat2007/ (last accessed April 21, 2008).

18. With respect to claims 12-15, 18-24, Applicants are reminded that functional recitation(s) using the word “for” only (*i.e.* not “means for” since “means for” phrases are interpreted in accordance with 35 U.S.C. §112 6th paragraph) or other functional terms (see *e.g.* “for a data center to process usage data of a value dispensing device” as recited in claim 12) have been considered but given less patentable weight⁶ because they fail to add any steps and are thereby regarded as intended use language. A recitation of the intended use of the claimed invention must result in additional steps. See *Bristol-Myers Squibb Co. v. Ben Venue Laboratories, Inc.*, 246 F.3d 1368, 1375-76, 58 USPQ2d 1508, 1513 (Fed. Cir. 2001) (Where the language in a method claim states only a purpose and intended result, the expression does not result in a manipulative difference in the steps of the claim.).

Response to Arguments

29. Applicant argued that the first and second audit reports are somehow different and not just consecutive instances of the same report from different months. As claimed, both reports have register values and a digital signature. Because there are no differences in the content and the claim language does not expressly preclude the Examiner’s view stated previously, the interpretation that the ending report for one period is the same as the beginning report of the subsequent period is maintained.

⁶ See *e.g. In re Gulack*, 703 F.2d 1381, 217 USPQ 401, 404 (Fed. Cir. 1983)(stating that although all limitations must be considered, not all limitations are entitled to patentable weight).

Conclusion

30. Any inquiry concerning this communication or earlier communications from the examiner should be directed to JOSHUA MURDOUGH whose telephone number is (571)270-3270. The examiner can normally be reached on Monday - Thursday, 7:00 a.m. - 5:00 p.m.

31. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Fischer can be reached on (571) 272-6779. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

32. Applicants are reminded that patents are written by and for skilled artisans. See *e.g. Vivid Technologies, Inc. v. American Science and Engineering, Inc.*, 200 F.3d 795, 804, 53 USPQ2d 1289, 1295 (Fed. Cir. 1999) ("patents are written by and for skilled artisans").⁷ The Examiner therefore starts with the presumption that Applicants are skilled artisans who possess at least ordinary skill in the art. Consequently, it is the Examiner's position that because the patent references of record are directed to those with ordinary skill in this art, these references are clear, explicit, and specific as to what they teach. Nevertheless some applicants apparently have difficulty understanding the references. In an effort to maintain compact prosecution, provide due process, and to help these applicants understand the contents of a reference when viewed from the position of one of ordinary skill in this art, Applicants are hereby given actual notice that if after reasonably reading any reference of record—whether the reference is currently of record or subsequently made of record—if Applicants can not reasonably understand or if Applicants have difficulty comprehending one or more sentence(s), statement(s), diagram(s), or

⁷ See also *S3 Inc. v. nVIDIA Corp.*, 259 F.3d 1364, 1371, 59 USPQ2d 1745, 1749-50 (Fed. Cir. 2001) ("patents are written for persons experienced in the field of the invention").

principle(s) set forth in the reference(s), Applicants should (in their next appropriately filed response) bring this issue to the attention of the Examiner. In addition to bringing this issue to the attention of the Examiner, and in accordance with 37 C.F.R. §1.111(b), Applicants' response must also state *why* they either do not understand or *why* they have difficulty comprehending the offending reference(s). If after properly receiving (*i.e.* Applicants' response is made of record) both Applicants' request for understanding and the reasons as to *why* the request is made—and assuming the reference is germane to at least one outstanding rejection—the Examiner may either provide a substitute reference, or alternatively, do his best to elucidate the particular sentence(s), statement(s), diagram(s), or principles(s) in the offending reference. For all documents or references made of record after this Office Action, Applicants are given actual notice that this paragraph becomes effective when Applicants receive notice that the document or reference is made of record (*i.e.* this paragraph becomes applicable when Applicants submit an Information Disclosure Statement or when Applicants receive an examiner's Notice of References Cited (Form PTO-892)).

33. Additionally, Applicants are also reminded that it is inappropriate for the USPTO to disregard any relevant evidence of record. "It is jurisprudentially inappropriate to disregard any relevant evidence on any issue in any case, patent cases included." *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 218 USPQ 871, 879 (Fed. Cir. 1983). Second, when making substantive patentability determinations, the USPTO uses the preponderance of the evidence standard.⁸ In light of this standard, it is clear error for the USPTO not to consider *all* evidence of record. See

⁸ See MPEP §706 I. "The standard to be applied in *all* cases is the 'preponderance of the evidence' test. In other words, an examiner should reject a claim if, in view of the prior art and evidence of record, it is more likely than not that the claim is unpatentable. [Emphasis added.]"

e.g. *In re Piasecki*, 745 F.2d 1468, 1471, 223 USPQ 785, 787 (Fed. Cir. 1984) (“All the evidence on the question of obviousness must be considered.”); *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992) (“After evidence or argument is submitted by the applicant in response, patentability is determined on *the totality of the record*, by a preponderance of evidence with due consideration to persuasiveness of argument. [Emphasis added.]”); *In re Glaug*, 283 F.3d 1335, 1338, 62 USPQ2d 1151, 1152-53 (Fed. Cir. 2002)(“Patentability vel non is then determined on the *entirety* of the record, by a preponderance of evidence and weight of argument. . . . ; patentability is determined by a preponderance of *all* the evidence. [Emphasis added.]”); and *In re Rinehart*, 531 F.2d 1048, 189 USPQ 143, 146 (CCPA 1976)(where the court expressly set forth the issue as “Whether, in light of *all the evidence*, the claimed method would have been obvious at the time the invention was made. [Emphasis added.]”). Third, any factual determination by the USPTO that does *not* consider all relevant evidence of record may not be supported by the required substantial evidence⁹ since the particular evidence *not* considered may be probative of a factual issue presented. Forth, prior art patents are not technical treatises and therefore these patents intentionally omit features that are known in the field of the invention. See *S3 Inc. v. nVIDIA Corp.*, 259 F.3d at 1371, 59 USPQ2d at 1749-50 (“The law is clear that patent documents need not include subject matter that is known in the field of the invention and is in the prior art, for patents are written for persons experienced in the field of the invention. ... To hold otherwise would require every patent document to include a technical treatise for the

⁹ See *In re Gartside*, 203 F.3d 1305, 1315, 53 USPQ2d 1769, 1775 (Fed. Cir. 2000) where the Federal Circuit concluded that USPTO’s factual findings must be supported by substantial evidence.

unskilled reader.”); and *Atmel Corp. v. Information Storage Devices, Inc.*, 198 F.3d 1374, 1382, 53 USPQ2d 1225, 1230 (Fed. Cir. 1999)(“The specification would be of enormous and unnecessary length if one had to literally reinvent and describe the wheel.”). Finally and perhaps most importantly, it is well established that “[a] reference anticipates a claim if it discloses the claimed invention ‘such that a skilled artisan could take its teachings in *combination with his own knowledge of the particular art and be in possession of the invention*. [Emphasis in original.]’” *In re Graves*, 69 F.3d 1147, 1152, 36 USPQ2d 1697, 1701 (Fed. Cir. 1995) citing *In re LeGrice*, 301 F.2d 929, 936, 133 USPQ 365, 372 (CCPA 1962) and noting that regarding the claimed “simultaneously monitoring the selected multiple connection points,” the prior art “nevertheless anticipates [the claimed invention], even if it does not specifically disclose simultaneous monitoring of the output points, if simultaneous or parallel monitoring is within the knowledge of a skilled artisan.” *Graves*, 69 F.3d at 1152, 36 USPQ2d at 1701.¹⁰ Therefore because, inter alia, it is inappropriate for the USPTO to disregard any relevant evidence, because the USPTO must consider all evidence of record, because any evidence or record *not* considered by the USPTO may be probative of at least one factual issue presented, because prior art patents need not include subject matter that is known in the field of the invention, and because anticipation is determined by the teachings of a reference in combination with the knowledge of one of ordinary skill in the art, Applicants are hereby given actual notice that all prior art rejections (*i.e.* rejection(s) based upon 35 U.S.C. §§ 102 or 103)—if found in this Office Action

¹⁰ See also *In re Donohue*, 766 F.2d 531, 533, 226 USPQ 619, 621 (Fed. Cir. 1985) for the same statement of law and also citing *In re LeGrice*; and *Ex parte Thomson*, 24 USPQ2d 1618, 1620 (B.P.A.I. 1992).

or any subsequent office action—are based upon the cited reference(s) in the statement of the rejection in combination with the knowledge of one of ordinary skill in this art.

34. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

J. M.
Examiner, Art Unit 3621

/ANDREW J. FISCHER/
Supervisory Patent Examiner, Art Unit 3621